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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,513	04/09/2004	Marc J. L'Heureux	7526-0001-1	9845

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,513

Applicant(s)

L'HEUREUX ET AL.

Examiner

Gary Estremsky

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 19 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/18/05</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It's not clear whether the "door having a face bore and an edge bore,..." is claimed as part of the invention or not. While the preamble of the claim recites "for use with,..." indicating the "door" is not part of the invention, other recitations within the body of the claim are not clear whether they can or should be properly interpreted as 'functionally reciting' the "door" and/or its geometry. It's not clear if broadest reasonable interpretation of the claim necessarily includes the "door" as part of the claimed invention. Positive recitations of the "door" and/or its structure include: "said collar has a dimension larger than a diameter of said edge bore", "said actuation member is spaced from an inner periphery of said face bore and extends into said face bore,...".

If the invention is to be defined in terms of the "door" and/or its geometry to patentably distinguish from prior art for example, it is suggested that the preamble be amended as –A temporary door latch mounted to a door,...–. If Applicant does not intend to claim the "door" as part of the invention, it is suggested that –adapted to,...– language be inserted in the body of the claim where appropriate to avoid positive

recitation of the "door" and/or its geometry. Similar positive or at least ambiguous recitations of the "door" and/or its geometry occur in dependent claims as well.

Clarification and/or correction is required as part of a complete Response.

Additionally as regards claim 8, it is not clear if the claim is attempting to include method steps in the intended process of using the claimed product as part of the invention in the "wherein" clause. It is not clear, structurally, what the scope of the limitation should include. Also see MPEP 2173.05(p) section II. It is suggested that the claim be amended to not include positive recitation of steps occurring, but be re-phrased as --wherein use, ...-- or other clear indication that claimed invention --is capable of-- performing the recited function.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 8, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,159,782 to Sales.

Sales '782 teaches Applicant's claim limitations including : a "longitudinal bolt portion" - including at 44 as shown on face of the Patent, an "actuation member" - at 58, a "collar" - at 54 as shown on the face of the Patent. As regards functional recitation accompanying "actuation member" for example, it's noted that recitation is not ignored,

but it has been phrased in terms of some intended use and does not patentably distinguish from the structure of the reference which can inherently be used in such manner. See MPEP 2114. It is the examiner's position that if the claim language is not interpreted as positively reciting the "door" and/or its associated geometry, the 'collar' of the reference reads on the limitation and inherently could be used with a bore having a diameter smaller than that of 54. Assuming the bore of the door is to be more clearly claimed in combination with the latch as the invention, the examiner recognizes that the reference illustrates collar 54 inserted into the bore as might be contrasted with such claim.

As regards claim 2, Sales '782 teaches a "threaded engagement member" - including 42, and "flange" - at 62.

As regards claim 3, the rounded upper surface indicated at 48 on the face of the Patent defines a "rib" meeting all limitations of the claim.

5. Claims 13 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,109,948 to Potter.

Potter '948 teaches Applicant's claim limitations including : a "longitudinal bolt portion" - the central portion of 31 as shown in Fig 3 for example, an "actuation member" - including 112, a "flexible neck portion" - including portion where 112 connects to 110.

6. Claims 13, 18-20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,848,813 to Fildan.

Fildan '813 teaches Applicant's claim limitations including : a "longitudinal bolt portion" - the cylindrical portion as shown in Fig 5 for example, an "actuation member" - including 120, a "flexible neck portion" - including 106.

As regards claim 19, the actuation mameber of the reference is inherently capable of substantially filling a small face bore where it's noted that limitation functionally recites the capability and does not include a "face bore" as part of the invention. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

#### ***Allowable Subject Matter***

7. Claims 19 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 5-7, 9-11, and 17 are would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,170,198 to Staples.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary Estremsky  
Primary Examiner  
Art Unit 3676